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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,393	07/18/2003	Kevin Conwell	13551	4619
7590 08/03/2006				
ORUM & ROTH 53 W. JACKSON BLVD CHICAGO, IL 60604			EXAMINER AHMAD, NASSER	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,393

Applicant(s)

CONWELL ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 10-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-8 and 10-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/3/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4-7, 16-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, the newly added phrase "allows low molecular weight mobile substances from the tire to diffuse through" does not have support in the specification as originally filed and is found to be new matter.

Claim 16, similarly, the phrase "wherein the base substrate allows low molecular weight substances from a tire to diffuse through" is also found to be new matter for lack of support therefor.

***Rejections Maintained***

3. Claims 8, 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar (6221453) for reasons of record made in the last Office Action of 2/24/2006.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar in view of Tuttle (6375780) for reasons of record made in the last Office Action of 2/24/2006.

***Response to Arguments***

5. Applicant's arguments filed 5/22/2006 have been fully considered but they are not persuasive.

Applicant argues that Majumdar's top layer has barrier properties while "polypropylene and polyolefin allow low molecular weight components in a tire to diffuse into the label stock". This is not deemed to be convincing because said phrase, in quotation, could not be located in the claims and cannot be read thereinto for the purpose of avoiding the applied prior art.

Regarding claim 15, the above explanation apply *a fortiori* herein.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is found to be obvious over the prior art of record discussed above.

***Rejections Withdrawn***

6. Claims 1, 4-7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar (6221453) made in the last Office Action of 2/24/2006 has been withdrawn in view of the amendment filed on 5/22/2006.

7. Claims 16-21, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar in view of Tuttle (6375780) made in the last Office Action of 2/24/2006 has been withdrawn in view of the amendment filed on 5/22/2006.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 4-7, 16-23 have been considered but are moot in view of the new ground(s) of rejection, when the new matter phrases are considered.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4-7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar (6221453).

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Majumdar relates to a tire label comprising a barrier layer of polyester (col. 3, lines 41-44) coated on a first side with adhesive (col. 3, lines 23-26) and provided on the other side of the barrier is a facestock or top layer of polyester (col. 4, lines 1-4). The facestock or top layer has a thickness of 5-100 microns (col. 4, lines 10-12) which includes the claimed range of 0.001 to 0.008 inches. The label, as a whole, is preferably less than 250 microns thick (col. 4, lines 10-20) and this would include the thickness range of the adhesive layer. The barrier coating inhibits migration of mobile substances from an object (abstract). The label can be provided with print. As for the stiffness, the label can be multilayered to provide for more stiffness to the label facestock (col. 4, lines 25-28). Further, because the label is applicable to a tire wall, it would be inherently conformable. However, Majumdar fails to teach that the facestock film has a stiffness of 20-80 mg (Gurley). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Majumdar by providing it's label facestock to have a stiffness of 20-80 mg (Gurley), based on optimization through routine experimentation, to exhibit optimum conformability

Further, Majumdar does teach the top layer (or facestock layer) can have barrier properties to the components in a black tire sidewall that will deactivate the fluorescent dyes and pigments (col. 3, lines 54-57). This is interpreted to allow the top to allow low molecular weight substances (as recited in claim 7) from the tire to diffuse through. In addition, the fluorescent dyes of Majumdar is dispersed in the facestock or top layer, and as such, said top layer would allow the low molecular weight mobile substances to

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diffuse through and the prevention of said diffusion is provided with the presence of the barrier layer.

11. Claims 15-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar in view of Tuttle (6375780).

Majumdar, as discussed above, fails to teach the presence of an RFID tag between the facestock and the barrier coating. Tuttle relates to an RFID tag located between a top and bottom polyester layers (col. 12, lines 55-60), wherein the top layer is taken to be the facestock and the bottom layer is interpreted to be the barrier layer. The lower surface of the bottom layer is provided with an adhesive layer (80). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Tuttle's teaching of providing an RFID tag between the top and bottom polyester layers in the invention of Majumdar with the motivation to provide protection to the RFID tag and identification of articles to which the tag is attached.

12. In response to applicants' arguments in the amendment filed on 5/22/2006, applicant is directed to the newly provided rejection over Majumdar for claims 1, 4-7 and 16-23.

13. Claims 1, 5-7, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilodeau (6235363).

Bilodeau relates to a removable tire side wall label comprising a label face stock (20) a

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thickness of between 0.3 to 20 mils (col. 3, lines 5-10), which reads on the recited thickness of 0.001 and 0.008 inches; the label face stock coated on a first side with a pressure sensitive rubber based adhesive (col. 4, lines 25-25) having a thickness of between 1.5 to 3.5 mils (col. 8, lines 47-48), which reads on the recited thickness of 0.001 and 0.004 inches, and a barrier coating (40) between the label face stock and the adhesive, wherein the label face stock allows low molecular weight mobile substances (such as plasticizer) from a tire to diffuse through (col. 1, lines 52-56 and col. 3, lines 43-46). Further, the formation of a multilayered facestock provide for stiffness thereto. However, Bilodeau fails to teach that the facestock film has a stiffness of 20-80 mg (Gurley). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bilodeau by providing it's label facestock to have a stiffness of 20-80 mg (Gurley), based on optimization through routine experimentation, to exhibit optimum conformability.

The barrier coating has a thickness of 1-25 microns (col. 10, lines 34-35).

14. Claims 16-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilodeau in view of Tuttle (6375780).

Bilodeau, as discussed above, fails to teach the presence of an RFID tag between the facestock and the barrier coating. Tuttle relates to an RFID tag located between a top and bottom polyester layers (col. 12, lines 55-60), wherein the top layer is taken to be the facestock and the bottom layer is interpreted to be the barrier layer. The lower surface of the bottom layer is provided with an adhesive layer (80). Therefore, it would



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have been obvious to one having ordinary skill in the art to utilize Tuttle's teaching of providing an RFID tag between the top and bottom polyester layers in the invention of Bilodeau with the motivation to provide protection to the RFID tag and identification of articles to which the tag is attached.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

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1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
July 31, 2006.